

### **REMARKS**

Reconsideration of the present application is respectfully requested. Claims 1-21 and 26-30 were rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,505,609 to Biester et al. ("Biester et al.") and claims 22-25 were rejected under 35 U.S.C. §103(a) over Biester et al. in combination with U.S. Patent No. 4,404,847. Applicants have canceled claims 1-16 and claims 22-30, leaving claims 17-21 pending. The rejection of claims 17-21 is traversed for the following reasons.

It is well settled that the Commissioner, through the Examiner, bears the initial burden of supplying a factual basis sufficient to support a rejection of a patent application, including a rejection under 35 U.S.C. §102. In re Warner 154 USPQ 173, 177 (C.C.P.A. 1967). Not only does a rejection under 35 U.S.C. §102 "require the disclosure in a single prior art reference of each element of the claim under consideration" (See, W.L. Gore and Assocs. Inc. v. Garlock, 220 USPQ 303, 313 (Fed. Cir. 1983)) but it further requires that "each and every element of the claimed invention, [must be] arranged as in the claim." See, Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir. 1984). "The identical invention must be shown in as complete detail as contained in the . . . claim." Richard v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

In light of the foregoing standards, Biester et al. fails to anticipate claim 17 for multiple reasons. Applicants note that the Office Action did not apply Biester et al. to claim 17, but instead focused its analysis on claim 1 which is not presently at issue.<sup>1</sup> It is submitted that Biester et al. fails to teach or suggest at least the following features of

claim 17: disabling a fuel injector, the first determining and the second determining. To the contrary, Biester et al. teaches only a fundamentally different mode of operation which the Examiner has correctly identified as being described by the Biester et al. specification. "The mode of proceeding according to [Biester et al.] is depicted in detail in FIG. 3 as a flowchart." Biester et al. column 4, line 1. The relevant particulars are as follows. First:

[Q]uery 304 checks whether voltage UI, applied at booster capacitor 145, is smaller than a threshold value S1. If this is not the case, then query 300 is carried out once again.

If voltage UI at booster capacitor 145 has dropped below a first threshold value S1, then in step 306 a time meter T is set at 0. Subsequent query 310 checks whether an operating state exists in which no combustion is possible.

Biester et al. column 4, lines 9-14. This disclosure does not teach or suggest the claimed first or second determining whether the voltage has met or exceeded a first value. To the contrary, Biester et al. makes clear that "[i]n the mode of operation depicted above, it is assured that the booster capacitor is charged if voltage UI at the booster capacitor drops below a threshold value S1." Biester et al. column 4, lines 39-41. This disclosure is also irrelevant to the claimed disabling a fuel injector. Next:

Query 330 checks whether voltage UI is larger than a second threshold value S2....

Query 330, in connection with query 318, checks whether a given voltage value S2 is achieved within a given time ST1. If voltage S2 is not achieved in the prescribed time ST1, then a fault in the area of output stage 230 and/or of control unit 220 can be assumed. In particular, a fault in the area of controlling the charging process is probable.

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<sup>1</sup> Applicants also expressly reserve the right to overcome the present §102(e) rejection by establishing an earlier date of invention.

Biester et al. column 4, line 60 – column 5, line 2. This disclosure does not teach or suggest the claimed first and second determining first determining whether the voltage has met or exceeded a first value. Query 330 is the only determination of a voltage exceeding a threshold value in Biester et al. Furthermore, as illustrated in FIG. 3 of Biester et al., query 330 is executed a single time. There is no logic flow path that would permit the control diagram to execute query 330 multiple times.

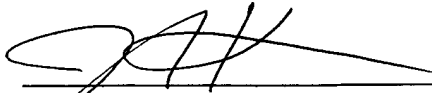
Finally, “in step 350, it is checked whether voltage UI is smaller than a third threshold value S3.” As was the case with query 304, this disclosure does not teach or suggest the claimed first or second determining first determining whether the voltage has met or exceeded a first value, and is irrelevant to the claimed disabling a fuel injector. Furthermore, Biester et al. never discloses the claimed disabling a fuel injector. Claims 18-21 depend from claim 17 and should not be rejected over Biester et al. for at least the reasons stated above in connection with claim 17.

Pursuant to the duty of disclosure in accordance with 37 CFR §1.56, applicants wish to bring to the attention of the Examining Attorney the patents listed on the attached PTO Information Disclosure Statement (IDS) form. The filing of this Information Disclosure Statement shall not be construed as an admission that the information cited is, or is considered to be, prior art or material to patentability as defined in §1.56(b). This Statement is being submitted along with the requisite fee in accordance with 37 CFR § 1.97(c).

The remaining issues in the Office Action are believed to be moot in light of the claim amendments. Reconsideration of the above-identified patent application and

timely allowance and issuance are respectfully requested. The Examiner is cordially invited to contact the undersigned by telephone to discuss any unresolved matters.

Respectfully Submitted,

A handwritten signature in black ink, appearing to read 'JAH', is written over a horizontal line.

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